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Paper No. 12

Michael B. Stewart
Charles A. Bieneman
Rader Fishman and Grauer PLLC
39533 Woodward Ave, Suite 140
Bloomfield Hills, Michigan 48304

In re Application of:
Andrew F. Suhy Jr.
Application No. 09/653,735
Filed: September 1, 2000
Attorney Docket No.: 65678-0032
For: APPARATUS AND METHOD FOR TRACKING AND MANAGING PHYSICAL ASSETS

DECISION ON PETITION UNDER 37 CFR 1.181

This is in response to applicants' petition under 37 CFR 1.181 filed October 4, 2003 requesting withdrawal of the finality of the Office action mailed August 12, 2003 as being premature.

The Petition is **DENIED.**

Applicant alleges that the final rejection mailed August 12, 2003 is premature because (1) the examiner did not respond to a number of applicant's arguments traversing the examiner's rejections, and (2) the examiner's rejections of the claims are not sufficiently detailed so as to make the issues between the examiner and the applicant sufficiently developed for appeal.

MPEP 706.07(a) sets forth that the second or any subsequent action on the merits shall be made final except where the examiner introduces a new ground of rejection that is neither necessitated by applicants' amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

A review of the record reveals that examiner has responded to applicant's arguments as a whole and has shown specific teachings in the references relied upon to support examiner's position with respect to the language of the claims. Applicant may disagree that examiner's response is complete or adequate, however, examiner has made a good faith effort to respond to applicant's arguments as well as provide a new ground of rejection when necessary

depending upon the amendments to the claims. Furthermore, the MPEP clearly states that the second or any subsequent action on the merits shall be made final except where the examiner introduces a new ground of rejection that is not necessitated by applicant's amendment. A review of the record further reveals that the examiner issued a new ground of rejection since the rejection was changed from a rejection based upon 35 U.S.C 102 in the office action mailed 13 March 2003 to a rejection based upon 35 U.S.C. 103 in the Final rejection mailed 12 August 2003. However, examiner clearly indicated that this new ground of rejection was necessitated by applicant's amendment. A review of applicants amendment filed 14 July 2003 shows that significant amendments were made to all the independent claims in addition to amendments to other claims that would necessitate a new ground of rejection by the examiner.

After further reviewing the record, the examiner's Final office action includes rejections for all the claims and their limitations. There is no requirement that the rejection be structured in such a way as to separately identify each claim and its limitations.

Furthermore, where differences of opinion concern the denial of patent claims because of prior art, and the questions thereby raised relate to the merits, then the appeal process has long been provided by statute. The MPEP clearly states under 37 CFR 1.191(a) that an applicant for a patent dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection. Thus, the application of the references to support the rejection of the claims by the examiner in this application is a matter appealable to the Board of Patent Appeals and Interferences.

For the foregoing reasons, the finality of the first office action is proper and no abuse of discretion or arbitrary or capricious action is evidenced and accordingly the petition to withdraw the finality of the final office action mailed 12 August 2003 is denied.

The file will be forwarded to the examiner to consider the amendment filed with the petition on October 14, 2003

John Love, Director
Patent Technology Center 3600
(703) 308-1020

JT/KJD: 11/24/03